

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant(s): Gary W. Ramsden)
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Application No.: 10/696,894)
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Filed: October 30, 2003)
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For: Automated Package Shipping Machine)
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Appeal No. 2007-3141)
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Customer No.: 27160)
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Confirmation No.: 9250)

REQUEST FOR REHEARING PURSUANT TO 37 CFR § 41.52

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Applicant respectfully requests a Rehearing of a Decision on Appeal, No. 2007-3141, decided October 10, 2007. The Commissioner is authorized to charge any required fees to Deposit Account No. 50-1214. The basis for this Request is set forth below. The Board is respectfully requested to consider this request and reconsider its decision.

ARGUMENTS

The Applicant respectfully disputes several of the findings of fact (FF) in the Board's decision, specifically, FF 02 and FF 10. In addition, it is respectfully submitted that the Board's decision is not in compliance with the guidelines promulgated in the **Examination Guidelines**

for Determining Obviousness Under 35 USC 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc., Federal Register , Vol. 72, No. 195, pages 57526-57535, dated October 10, 2007 (“the Guidelines”).

The Guidelines specifically require that the fact finder, in this case, the Board, provide specific findings of fact to establish compliance that the factual inquiries required by Graham v. John Deere, 383 US 1 (S.Ct 1966) (“Graham”) have been made. (Guidelines, page 57527). These findings of fact are to be used as the “underpinnings to establish obviousness” (Guidelines, page 57527). It is respectfully submitted that certain findings of fact are not in compliance with the Guidelines and several findings of fact illustrate a misapprehension of several of the issues by the Board. As such, the Applicant respectfully requests reconsideration of its decision and a reversal of the Examiner’s rejection of the Claims..

In particular, both the Guidelines and Graham require that **all** of the differences between the claimed invention and the prior art be determined. Although some of the differences have been stated in the Decision, several important elements recited in the claims at issue have not even been mentioned. For example, Claim 77 recites a printer for printing a shipping receipt that includes the cost of delivering the parcel to the destination by the delivery option selected by the customer. This difference is not included in any of the findings of fact and appears to have been ignored by the Board.

This difference between the invention and the references is set forth below. In particular, the primary reference, Hsieh US Patent No. 4,923,022 (“the Hsieh patent) relates to an “Automatic Mailing Apparatus” for use after hours by customers. (In addition, a person can mail ...letters at any time of day or night...” Hsieh patent Col. 2, lines 1-2). The Hsieh patent does not disclose a printer The Pusic US Patent No. 5,065,000 (“the Pusic patent”) does disclose a printer. However, neither the Hsieh nor Pusic patents disclose a printer for printing a receipt as recited in claim 77. In as much as neither of the cited references disclosed this element, it was incumbent upon the Board to at least show that such an element was within the ordinary skill in the art at the time of the invention, which was not done.

Even so, the Board indicates on page 11 of the Decision that; “Pusic describes the advantages of applying its printing technique to any postal meter such as Hsieh’s (FF 07 and FF 08). Thus, Pusic itself provides the suggestion to combine its teachings with Hsieh.” First of all, the apparatus disclosed in the Hsieh device is not a “postal meter” per se in the sense of the Pusic apparatus. In particular, the Hsieh apparatus relates to a machine which does not include a keyboard and which stores the parcel within the machine. In the Hsieh apparatus, the parcel is deposited in the machine presumably with a mailing label furnished by the customer beforehand and stored. As such, there is no need for a label and thus a printer in the Hsieh apparatus as suggested by the Board. Moreover, the Hsieh apparatus does not have a keyboard but rather includes letter sorting keys 22 which operate solenoids for sorting the parcels. The Pusic patent teaches a keyboard for receiving input from a customer and using that information in its printing process. If anything, it is respectfully submitted that the references teach away from combination with each other

Notwithstanding the above, even assuming that the teachings of the Pusic patent could be combined with the teachings of the Hsieh, the resulting combination still would not anticipate the claims at issue since neither patent describes a printer for printing a receipt as described. As mentioned above, neither the Pusic nor the Hsieh patents disclose an apparatus having a printer with the capability as recited in Claim 77.

In addition, The Guidelines as well as the **Graham** case require a finding of the level of skill in the art at the time of the invention. Other than FF 10, no such finding has been made. FF 10 states that; “one of ordinary skill in the *postal fee setting art* would consider a delivery option to be a *predictable* member of the set of special request data described by Pusic.” The finding of the level of skill in the art is to be made at the time of the invention. The term “predictable” indicates that such a feature was not known at the time of invention. Both the Hsieh and Pusic references are indicative of the state of the art at the time of the invention. Neither of these references disclose the feature.. Moreover, a person in the “postal fee setting art” as set forth in FF 10 would appear to be administrative employee of the US Postal Service with no technical

abilities with respect to “postage meters” or “automatic mailing apparatus” and thus would be unable to combine the teachings of the Pusic and Hsieh references.

As mentioned above, the Applicant respectfully disagrees with several of the findings of fact and specifically FF 02 and FF 10. FFG 10 was discussed above FF 02 indicates that; “The phrase ‘function’ modifies ‘cost’ not ‘destination’ because the phrase ‘to the destination’ is itself a modifier of cost and a destination has no weight. In an obviousness analysis, the claims are to be construed. The claims are to be construed in accordance with the specification. The Court of Appeals for the Federal Circuit has again emphasized the rules of claim construction in an obviousness analysis **In re TRANSLOGIC TECHNOLOGY, INC.** Appeal No. 2006-1192, 2007 U.S. App. LEXIS 23969, decided on October 7, 2007. Specifically, on page 6 of the slip opinion , the Court stated: “In *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), [HN3] this court set forth the best practices for claim construction. According to that decision, the words of a claim "are generally given their ordinary and customary meaning." *Id.* at 1312. The ordinary and customary meaning "is the meaning that the term [*15] would have to a person of ordinary skill in the art in question." *Id.* at 1313. For this reason, "claims must be read in view of the specification, of which they are a part." *Id.* at 1315. (internal quotations omitted). The specification "is the single best guide to the meaning of a disputed term."

Indeed the claims are to be read in light of the specification. The construction by the Board in FF 02 is not supported by the specification. As clearly set forth in the specification page 37, line 20 to page 38, line 32, cost is calculated as a function of weight, destination and delivery option. It is respectfully submitted that the construction by the Board is not supported by the specification and thus runs afoul of the rules for claim construction set forth by the Court of Appeals for the Federal Circuit. Even assuming *arguendo* that the claim language is ambiguous, the ambiguity is to be resolved by resort to the specification. It appears that the Board is interpreting the disputed claim language to read that the cost for postage is the same for all destinations US and International. Assuming *arguendo* that the claim language is ambiguous, the specification and not rules of grammar are to be used to properly construe the claim. Not only is

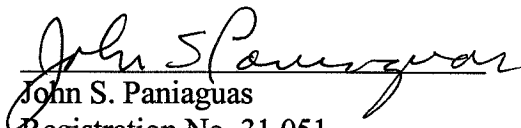
the Board's construction of the disputed claim language inconsistent and not supported by the specification but it ignores the fact that the claim actually does recite "computing a cost for mailing said parcel or envelope to said destination...." It is implicit that the cost will vary depending on the destination as set forth in the specification. The claim also recites that the cost to the destination will also be determined as a function of the weight and the selected delivery option. As such, it is respectfully submitted that a fair reading of the claim language simply suggests that this cost will vary depending on (i.e. as a function of) three variables: namely, destination, weight and the selected delivery option.

Perhaps an example may be illustrative of a reasonable interpretation of the claim language that is consistent with the specification. Assume that it cost \$1.00 to ship a parcel weighing 1 pound by regular mail to a US destination. Further assume that the weight of the parcel is 2 pounds and the selected delivery option is express service and the destination is Canada, and the cost is \$10.00. Thus, in the above example, the cost to a specific **destination** depends on (or is a function) of the delivery option and the weight as well as the destination.. Accordingly, the Applicant respectfully disputes the FF 02 that states that the term destination is given no weight and respectfully submits that such a construction is improper.

As set forth by the US Supreme Court in **Graham** , *supra*, obviousness is a question of law based upon underlying factual inquiries. It is respectfully submitted that several of the factual inquiries by the Board as set forth as findings of fact in the Decision are disputed as set forth above and that not all of the factual inquiries are complete. In as much as these factual inquiries are the underpinning of a legal conclusion of obviousness, the Board is respectfully requested to reconsider its earlier decision and reverse the Examiner's rejection of the claims.

Respectfully submitted,

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